



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/314,159	05/19/99	MUSER	1579-367

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EXAMINER
HUNT, J

ART UNIT	PAPER NUMBER
1642	4

DATE MAILED: 09/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/314,159

Applicant(s)

Moser et al.

Examiner
Jennifer Nichols, Nee Hunt

Group Art Unit
1642



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-24 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-24 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1642

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, 10, 13, and 14, drawn to methods of screening a test compound for its ability to modulate binding or bioactivity, classified in class 436, subclass 501.
 - II. Claims 8, 12, 15, 16, and to claims 1 and 10 to the extent that they read on claims 8 and 12, drawn to angiostatin inhibitors, antagonists, and methods of inhibiting angiostatin activity, classified in class 514, subclass 2.
 - III. Claims 9, 11, 17, and to claims 1 and 10 to the extent that they read on claims 9 and 11, drawn to angiostatin enhancers, agonists, and methods of enhancing angiostatin activity, classified in class 514, subclass 2.
 - IV. Claims 18-20, drawn to a vector and nucleic acid sequence, host cell, and method of producing the alpha subunit of ATP synthase or angiostatin binding portion thereof, classified in class 435, subclass 320.1, 325 and class 536, subclass 23.1.
 - V. Claim 21, drawn to an antibody which binds the alpha subunit of ATP synthase or angiostatin binding portion thereof, classified in class 530, subclass 387.1.
 - VI. Claim 22, drawn to a kit comprising ATP synthase or angiostatin binding portion thereof and angiostatin or truncated form thereof, classified in class 436, subclass 808.

Art Unit: 1642

VII. Claims 23-24, drawn to an isolated complex comprising angiostatin and ATP synthase or angiostatin binding portion thereof, classified in class 514, subclass 2.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Groups II and III are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the products of Groups II and III can be made by a materially different process, such as by chemical synthesis.

The inventions of Groups II-VII are drawn to materially different products, having different structures, different physical properties, and different biological functions. The product of Group II is drawn to antagonists, which have mutually exclusive functions from the product of Group III which is drawn to agonists. The invention of Group IV is drawn to a nucleic acid sequence, vector, and method of expressing the sequence, which is a completely different structure from that of the peptides of Groups II and III. The product of Group V is drawn to an antibody which is a completely different peptide from those of Groups II and II, having different structures and functions. The product of Group VI is drawn to a kit, which comprises a multitude of different peptides, distinct from those of Groups II, III and V. The product of Group VII is a complex, which is different from the peptides of the aforementioned Groups. Therefor

Art Unit: 1642

the products of Groups II-VII are distinct, having different structure, function and properties, as set forth above.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and because the search required for any one Group is not required for any other Group, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

The invention of Group I contains the following species:

a. Methods of screening a test compound for it's ability to enhance binding of angiostatin.

b. Methods of screening a test compound for it's ability to inhibit binding of angiostatin.

These methods are drawn to completely different and mutually exclusive species.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

Art Unit: 1642

thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Art Unit: 1642

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Nichols, whose telephone number is (703) 308-7548. The examiner can normally be reached Monday through Thursday 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached at (703) 308-3995. The fax number for the group is (703) 305-3014 or (703) 308-4242.

Communications via internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [anthony.caputa@uspto.gov].

All internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists the possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist, whose telephone number is (703) 308-0196.

Jennifer Nichols, Nee Hunt

September 19, 2000


BRENDA BRUMBACK
PATENT EXAMINER